UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,806	05/27/2005	Bernd Wenderoth	3557-43	4541

23117 7590 10/15/2010

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
OGDEN JR, NECHOLUS	

ART UNIT	PAPER NUMBER
1761	

MAIL DATE	DELIVERY MODE
10/15/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND WENDEROTH and BIRGIT FLAIG

Appeal 2009-012419
Application 10/536,806
Technology Center 1700

Before CHUNG K. PAK, CHARLES F. WARREN, and
TERRY J. OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

The Appellants request reconsideration of our Decision (mailed May 27, 2010) wherein we affirmed the rejection of claims 1-6 under 35 U.S.C. § 103 over Eaton in view of Wenderoth and over Boon in view of Wenderoth.

The Appellants argue, in reliance upon the Board's precedential decision *In re Quist*, Appeal No. 2008-001183 (BPAI June 2, 2010), that we improperly did not determine patentability based upon the totality of the record because we focused on the Appellants' evidence and did not analyze

the prima facie case of obviousness (Request 1-2). The Appellants argue that "[a] *prima facie* case is not "overcome" by secondary considerations; the evidence used to create the *prima facie* case is simply reevaluated" (Request 2).

As stated by the Federal Circuit, "[o]n appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of obviousness." *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Appellants argue that "Appellants did not acquiesce to the establishment of a *prima facie* case, rather Appellants merely did 'not dispute that the individual components were extant at the time the application was filed'" (Request 2). The Appellants argue that there was an evidence based expectation that electrical conductivity will increase over time in similar compositions and that the Appellants' invention cuts against that evidence based expectation (Request 2-3).

The Appellants did not provide a substantive argument regarding the Examiner's rationale as to the existence of a prima facie case of obviousness.[1] The Appellants relied only upon their evidence that the electrical conductivity of their claimed composition remains low over time (Br. 11-16; Reply Br. 1-4). As pointed out in our Decision that evidence is

[1] Thus, in this case the requirement that that after evidence has been submitted in rebuttal to a prima facie case "the entire path to decision be retraced", *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976), does not require a discussion of the prima facie case.

in adequate for showing unobviousness because it does not compare the claimed composition to the closest prior art[2] and it is not commensurate in scope with the claims (Decision 3-5).

DECISION/ORDER

We have considered the Appellants' request for reconsideration of our Decision but for the above reasons we decline to make any change thereto.

DENIED

sld

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

[2] Hence, the Appellants' argument that their evidence compares the claimed composition to "similar compositions" (Request 3) is not well taken.